

REMARKS

Claims 1-15 are pending in this application. Claims 1, 9, 10, and 15 stand rejected. Applicant wishes to thank the Examiner for the indication of allowance of claims 2-8 and 11-14. By this Amendment, claim 15 has been amended. The amendments made to the claim do not alter the scope of the claim, nor have the amendments been made to define over the prior art. Rather, the amendments to the claim have been made for cosmetic reasons to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claim 15 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant respectfully requests reconsideration and withdrawal of this rejection. The claim states "storing a data length of said video data and said non-video data written in said secondary store in order of said data stream being input into a secondary store." Applicant has amended the occurrence of "a secondary store" to be "the secondary store." However, Applicant has not made the other change requested by the Examiner. There are two separate pieces of data being stored -- a data length of said video data and the non-video data. The data length of the non-video data is not being stored as asserted in the Office Action. See Office Action at 3. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 1 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,748,020 ("Eifrig"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

In the Office Action, it is asserted that the explicitly recited extracting means are disclosed by audio delay units 340,342, and 344. However, in the response to arguments, the Examiner states that the extracting means are taught because the claims do not require a separate unit in order to perform the extracting means, merely a

means to extract the stored data. The Office Action specifically asserts that “elements (340, 342, and 344) store the data not to be processed (audio) and then proved [sic] the data to the REMUX (336) in order to be combined with the processed data (video) (col. 8, Ins. 30-33). Though it is unclear if the extracted means is performed by the elements or the REMUX, the fact remains that the extracting means is performed. See Office Action at 2.

Applicant respectfully disagrees that the extracting means are set forth in either the audio delay units or the REMUX. Specifically, in Eifrig, the audio portions which have been delayed by the respective functions 340, 342, and 344 are recombined with the transcoded video data at the REMUX 336. Thus, there is no extraction taking place at either the delay units or the REMUX but merely delay and recombination. Because the REMUX is recombining the signals, there is no extraction of data not to be processed but merely the storing and then recombining of said audio data.

Likewise, claim 9 explicitly recites extracting from said secondary storing section. Said secondary data block not to be processed in accordance with said order of said inputted MPEG data. Again, extracting from said secondary store is not the combining function performed by the REMUX or the delay performed by elements 340, 342, and 344. Therefore, claims 1 and 9 are allowable over Eifrig.

Claim 10 depends from, and contain all the limitations of claim 9. This dependent claim also recites additional limitations which, in combination with the limitations of claim 9, are neither disclosed nor suggested by Eifrig and is also believed to be directed towards the patentable subject matter. Thus, claim 10 should also be allowed.

Claims 1 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,081,295 (“Adolf”) in view of U.S. Patent No.

5,287,182 ("Haskell"). Applicants respectfully request reconsideration and withdrawal of this rejection.

As noted by the Office Action, Adolph does not teach secondary storing means which store the number of said first data storing, said primary storing means or said plurality of second data to be not processed. However, the Office Action notes that Adolph discloses a buffer in the video processor portion of the disclosed circuit. To cure the deficiency in Adolph, the Office Action asserts that one would combine Haskell for its teaching of a buffer in an audio processing system. The Office Action asserts that one would be motivated to combine these references since Adolph discloses a buffer to process the MPEG stream and Haskell teaches the use of a buffer for processing audio that one would combine the two processing techniques to arrive at Applicant's claims. This assertion is incorrect.

Applicants respectfully submit that the Office Action fails to provide a proper motivation to combine the cited references and therefore requests reconsideration and withdrawal of this rejection.

Simply because information is well known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. Id. Inventions are frequently the process of combining prior art in a nonobvious manner. Id.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and,

in combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See, Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action's sole justification for combining Adolph and Haskell in the rejection of claims 1 and 9 is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would add the "audio processor would contain a buffer as Adolph teaches the use of a buffer in a

processor used to process part of the mpeg stream and Haskell further teaches the use of a buffer for processing audio.” See Office Action, at 7. This assertion, however, is merely conclusory. The simple statement that the combination of Adolph and Haskell would yield the claimed invention does not say how or why a person of ordinary skill in the art would be motivated to modify Adolph in light Haskell.

In the response to arguments, the Examiner asserts that Adolph teaches a system for dividing a stream into audio and video components with the video components being processed and then being recombined with the audio components. The Examiner then asserts it is well-known in the art that performing such assessing on a video stream will require several cycles and that the unprocessed streams must be buffered. The Examiner then asserts that Eifrig shows this feature. However, in a rejection, the Examiner has not included Eifrig in the combination but merely asserts that Adolph shows a portion of Applicant’s claimed invention and that Haskell cure the deficiency noted in Adolph. However, as discussed herein, this incorrect. Further, Applicant notes that the system of Adolph functions without a delay and therefore adding a delay would improperly change the principal operation in Adolph.

The claimed combination cannot change the principle of operation of the primary reference, render the reference inoperable for its intended purpose, or change the principle of operation of a reference. See, M.P.E.P. § 2143.01. If the buffer were included in the audio data processing arm of the system, it would change the operation of the disclosed system as the audio and video signals would no longer be synchronized. There would be no motivation to include additional delay the video portion of the circuit merely to unnecessarily delaying the audio processing portion of the circuit. *Id.* Therefore, Applicant respectfully submits that it would not have been obvious to modify the disclosed system in Adolph with the teaching of Haskell. Thus, Applicant respectfully submits that claims 1 and 9 are allowable over Adolph in combination with Haskell.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the technique of components disclosed in Adolph in light Haskell. As a result, the Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1 and 9 and that the objection to those claims under Section 103 should be withdrawn.

The Office Action has failed to show a motivation in the cited references for combining technique of the Costa with the device shown in Robinson. See M.P.E.P. § 2143. Absent a showing of such a motivation, a *prima facie* case of obviousness cannot be made. As such, if the Examiner persists in stating that such motivation is known, Applicant requests that the Examiner set forth a reference which shows such a motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art and that one with ordinary skill in the art would be motivated to combine such knowledge with Saints so that Applicant has the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No. 10/053,184

Docket No.: K3281.0010

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By 

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